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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			RAMPURIA, SHARAD K	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/727,433	Applicant(s) BELKIN ET AL.	
	Examiner Sharad Rampuria	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. The current office-action is in response to the amendment/arguments filed on 1/19/06.

Accordingly, Claims 9 and 20-27 are cancelled and Claims 1-8 and 10-19 are pending for further examination as follows:

Claim Rejections - 35 USC § 102

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

III. Claims 1-5, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Segal et al. (US 20050119005).

The applied reference has a common assignee or a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As per claim 1, Segal teaches:

Art Unit: 2617

A wireless communication unit (101; Fig.1, Abstract) arranged and constructed for operation within a loosely coupled communication network (Pg.2; 0017) comprising a first communication network (103; Fig.1) and a second communication network (105; Fig.1), the wireless communication unit (Abstract, Pg.2; 0017) comprising:

A transceiver (203; Fig.2) configured to support an air interface with the first communication network and with the second communication network; (i.e. transceiver; Pg.4; 0028) and

A controller (209; Fig.2) arranged to control and cooperatively operate with the transceiver to manage and retrieve an on-hold call from the first communication network after a handout of the wireless communication unit from the first communication network to the second communication network via a call leg established to support the on-hold call to and while the wireless communication unit is operating in the second communication network. (i.e. The communication network switch further comprises the controller 305 that is arranged to control and cooperatively operate with the switching function to place an active call on-hold responsive to a signal from a communication unit to provide an on-hold call at the first communication network and thereafter couple, via a call leg to the second communication network, the on-hold call to the wireless communication unit, the call leg established for coupling the on-hold call to the wireless communication unit after a handout of and while the wireless communication unit is operating in the second communication network; Pg.6; 0041, Pg.9; 0057, Abstract and Claim 1).

As per claim 2, Segal teaches:

Art Unit: 2617

The wireless communication unit of claim 1 wherein the controller cooperatively with the transceiver is operable to one of disconnect and place on-hold an active call over the call leg and then connect the on-hold call, where the on-hold call is coupled from the first communication network to the wireless communication unit via the second communication network over the call leg. (Pg.4; 0028)

As per claim 3, Segal teaches:

The wireless communication unit of claim 1 wherein the on-hold call is one of i) automatically coupled to the wireless communication unit responsive to one of disconnecting and placing on-hold an active call and ii) connected to the wireless communication unit responsive to signaling provided to the first communication network via the call leg by the controller cooperatively with the transceiver. (Pg.4; 0029)

As per claim 4, Segal teaches:

The wireless communication unit of claim 3 wherein the controller cooperatively with the transceiver uses one of in-band and out of band signaling to provide a code to the first communication network that one of connects an on-hold call, disconnects an active call, and places an active call on-hold. (i.e. a unique identifier; Pg.4; 0033)

As per claim 5, Segal teaches:

The wireless communication unit of claim 4 wherein the on-hold call is a plurality of on-hold calls and the controller cooperatively with the transceiver is operable to one of connect,

Art Unit: 2617

disconnect, and place back on-hold one of the plurality of on-hold calls and to receive a second of the plurality of on-hold calls until all of the plurality of on-hold calls have been disconnected.

(Pg.4; 0034)

As per claim 11, Segal teaches:

A communication network switch (112; Fig.1, Abstract) operable to route calls for a first communication network, the communication network switch (112; Fig.1, Abstract) comprising:

A switching function operable to couple the first communication network to a second communication network, where the first communication network and the second communication network comprise a loosely coupled communication network; (Abstract, Pg.2; 0017, Pg.4; 0030) and

A controller (209; Fig.2) arranged to control and cooperatively operate with the transceiver to manage and retrieve an on-hold call from the first communication network after a handout of the wireless communication unit from the first communication network to the second communication network via a call leg established to support the on-hold call to and while the wireless communication unit is operating in the second communication network. (i.e. The communication network switch further comprises the controller 305 that is arranged to control and cooperatively operate with the switching function to place an active call on-hold responsive to a signal from a communication unit to provide an on-hold call at the first communication network and thereafter couple, via a call leg to the second communication network, the on-hold call to the wireless communication unit, the call leg established for coupling the on-hold call to the wireless communication unit after a handout of and while the wireless communication unit is

operating in the second communication network; Pg.6; 0041, Pg.9; 0057, Abstract and Claim 1).

As per claim 12, Segal teaches:

The communication network switch of claim 11 further comprising a mobility manager that is operable to facilitate mobility of wireless communications units including the wireless communication unit by tracking network contacts for the wireless communication units, wherein the mobility manager cooperatively with the controller and the switching function is operable to establish the call leg between the second communications network and the first communications network. (Pg.4; 0030)

As per claim 13, Segal teaches:

The communication network switch of claim 12 wherein the controller cooperatively with the switching function is operable to connect the on-hold call by one of i) automatically connecting the on-hold call to the wireless communication unit responsive to one of disconnecting and placing on-hold an active call and ii) connecting the on-hold call to the wireless communication unit responsive to signaling received by the communication network switch from the wireless communication unit over the call leg. (Pg.6; 0043)

Claim Rejections - 35 USC § 103

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

V. Claims 6-8, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal in view of Buttitta et al. [US 5913166].

As per claim 6, Segal teaches all the particulars of the claim except the unique codes includes a code corresponding to each of the plurality of on-hold calls that can be used to connect the each of the plurality of on-hold calls. However, Buttitta teaches in an analogous art, that the wireless communication unit of claim 5 wherein the controller cooperatively with the transceiver uses the in-band signaling to provide unique codes to the first communication network where the unique codes includes a code corresponding to each of the plurality of on-hold calls that can be used to connect the each of the plurality of on-hold calls. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the unique codes includes a code corresponding to each of the plurality of

Art Unit: 2617

on-hold calls that can be used to connect the each of the plurality of on-hold calls in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 7, Segal teaches all the particulars of the claim except the controller cooperatively with the transceiver uses the in-band signaling to one of provide one of the unique codes to disconnect the active call and provide another one of the unique codes to place the active call on-hold. However, Buttitta teaches in an analogous art, that the wireless communication unit of claim 6 wherein the controller cooperatively with the transceiver uses the in-band signaling to one of provide one of the unique codes to disconnect the active call and provide another one of the unique codes to place the active call on-hold. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the controller cooperatively with the transceiver uses the in-band signaling to one of provide one of the unique codes to disconnect the active call and provide another one of the unique codes to place the active call on-hold in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 8, Segal teaches all the particulars of the claim except the user interface is operable to indicate to the controller when to one of disconnect the active call, place the active call on-hold, select the on-hold call that will be connected, select a next on-hold call to be connected, and select a previous on-hold call to be connected. However, Buttitta teaches in an

Art Unit: 2617

analogous art, that the wireless communication unit of claim 7 further comprising a user interface coupled to the controller, wherein the user interface is operable to indicate to the controller when to one of disconnect the active call, place the active call on-hold, select the on-hold call that will be connected, select a next on-hold call to be connected, and select a previous on-hold call to be connected. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user interface is operable to indicate to the controller when to one of disconnect the active call, place the active call on-hold, select the on-hold call that will be connected, select a next on-hold call to be connected, and select a previous on-hold call to be connected in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 14, Segal teaches all the particulars of the claim except the controller cooperatively with the switching function receives a code via one of in-band and out of band signaling and responsive to the code, one of connects an on-hold call, disconnects an active call, and places an active call on-hold. However, Buttitta teaches in an analogous art, that the communication network switch of claim 13 wherein the controller cooperatively with the switching function receives a code via one of in-band and out of band signaling and responsive to the code, one of connects an on-hold call, disconnects an active call, and places an active call on-hold. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the controller cooperatively with the switching function receives a code via one of in-band and out of band signaling and responsive to the code, one of

Art Unit: 2617

connects an on-hold call, disconnects an active call, and places an active call on-hold in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 15, Segal teaches:

The communication network switch of claim 14 wherein the on-hold call is a plurality of on-hold calls and the controller cooperatively with the switching function is operable to one of connect, disconnect, and place back on-hold one of the plurality of on-hold calls and to connect a second of the plurality of on-hold calls until all of the plurality of on-hold calls have been disconnected. (i.e. a unique identifier; Pg.4; 0033)

As per claim 16, Segal teaches all the particulars of the claim except the controller cooperatively with the switching function receives unique codes via the in-band signaling, where the unique codes include a code corresponding to each one of the plurality of on-hold calls and indicates to the communication network switch which of the plurality of on-hold calls should be connected. However, Buttitta teaches in an analogous art, that the communication network switch of claim 15 wherein the controller cooperatively with the switching function receives unique codes via the in-band signaling, where the unique codes include a code corresponding to each one of the plurality of on-hold calls and indicates to the communication network switch which of the plurality of on-hold calls should be connected. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the controller cooperatively with the switching function receives unique codes via the in-band

Art Unit: 2617

signaling, where the unique codes include a code corresponding to each one of the plurality of on-hold calls and indicates to the communication network switch which of the plurality of on-hold calls should be connected in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 17, Segal teaches all the particulars of the claim except the controller cooperatively with the switching function receives, via the in-band signaling, one of the unique codes to indicate that the active call should be disconnected and another one of the unique codes to indicate that the active call should be placed on-hold. However, Buttitta teaches in an analogous art, that the communication network switch of claim 16 wherein the controller cooperatively with the switching function receives, via the in-band signaling, one of the unique codes to indicate that the active call should be disconnected and another one of the unique codes to indicate that the active call should be placed on-hold. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the controller cooperatively with the switching function receives, via the in-band signaling, one of the unique codes to indicate that the active call should be disconnected and another one of the unique codes to indicate that the active call should be placed on-hold in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

As per claim 18, Segal teaches all the particulars of the claim except the mobility manager is further operable to order the plurality of on-hold calls according to a call identifier corresponding to each of the on-hold calls and assign the code corresponding to each of the plurality of on-hold calls according to the order, thereby allowing the first communication network and the wireless communication unit to refer to the same on-hold call with a corresponding unique code. However, Buttitta teaches in an analogous art, that the communication network switch of claim 17 wherein the mobility manager is further operable to order the plurality of on-hold calls according to a call identifier corresponding to each of the on-hold calls and assign the code corresponding to each of the plurality of on-hold calls according to the order, thereby allowing the first communication network and the wireless communication unit to refer to the same on-hold call with a corresponding unique code. (Col.7; 36-Col.8; 4) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the mobility manager is further operable to order the plurality of on-hold calls according to a call identifier corresponding to each of the on-hold calls and assign the code corresponding to each of the plurality of on-hold calls according to the order, thereby allowing the first communication network and the wireless communication unit to refer to the same on-hold call with a corresponding unique code in order to provide wireless radio telephones and, more particularly, to radio telephones operative with a private base station and public base stations in a wireless system.

VI. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segal in view of Ejzak [US 6871070].

As per claim 10, Segal teaches all the particulars of the claim except the signaling is one of Dual Tone Multi Frequency (DTMF) signaling. However, Ejzak teaches in an analogous art, that the wireless communication unit of claim 3 wherein the signaling is Dual Tone Multi Frequency (DTMF) signaling. (Col.6; 1-7) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the signaling is one of Dual Tone Multi Frequency (DTMF) signaling in order to provide communication systems, and more particularly to a third generation wireless communication system.

VII. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segal & Buttitta further in view of Ejzak.

As per claim 19, the above combinations teach all the particulars of the claim except the signaling is one of Dual Tone Multi Frequency (DTMF) signaling. However, Ejzak teaches in an analogous art, that the communication network switch of claim 18 wherein the signaling is Dual Tone Multi Frequency (DTMF) signaling. (Col.6; 1-7) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the signaling is one of Dual Tone Multi Frequency (DTMF) signaling in order to provide communication systems, and more particularly to a third generation wireless communication system.

Conclusion

VIII. ***Applicant's arguments filed on 1/19/2006 have been fully considered but they are not persuasive.***

Art Unit: 2617

In response to Applicant's argument that Segal doesn't teach, "A controller arranged to control and cooperatively operate with the transceiver to manage and retrieve an on-hold call from the first communication network after a handout of the wireless communication unit from the first communication network to the second communication network via a call leg established to support the on-hold call to and while the wireless communication unit is operating in the second communication network;" it is noted that Segal supports the assertion as, The communication network switch further comprises the controller 305 that is arranged to control and cooperatively operate with the switching function to place an active call on-hold responsive to a signal from a communication unit to provide an on-hold call at the first communication network and thereafter couple, via a call leg to the second communication network, the on-hold call to the wireless communication unit, the call leg established for coupling the on-hold call to the wireless communication unit after a handout of and while the wireless communication unit is operating in the second communication network (see Pg.6; 0041, Pg.9; 0057, Abstract and Claim 1). Hence, it is believed that Segal teaches the claimed limitations.

For that reason, it is believed and as enlighten above, the rejections should be sustained.

IX. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

Art Unit: 2617

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870.

The examiner can normally be reached on M-F. (8:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or EBC@uspto.gov.

Sharad Rampuria
Examiner
Art Unit 2617


GEORGE ENG
SUPERVISORY PATENT EXAMINER